REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on May 22, 2003, and the references cited therewith. Claims 1, 13 and 23 have been amended. Applicant respectfully submits that such amendments are not related to patentability. Claims 1-30 remain pending in this application. Applicant does not admit that the cited references are prior art and reserves the right to "swear behind" each of the cited references as provided under 37 C.F.R. 1.131.

§103 Rejection of the Claims

Claims 1-5 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.* (ACM, pp. 158-169 (November 1999)) in view of Chaddha (U.S. 6,215,910). Applicant respectfully traverses the rejections.

In order for the Examiner to establish a *prima facie* case of obviousness rejection, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness because one of the cited references (Chaddha) is nonanalogous art. Analogous art is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology. *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979).

Chaddha relates to an "image compression system." See Chaddha in the Abstract. Chaddha (in relation to the claimed invention) is not analogous by either definition, as set forth above. Image compression (Chaddha) is not the same field of technology as code reuse (the

claimed invention). Moreover, Chaddha does not deal with the same problem as the claimed invention. Chaddha is dealing with the problem of network bandwidth:

> In most cases, the raw data requirements for such applications far exceed available bandwidth, so data compression is necessary to meet the demand. Chaddha at column 1, lines 19-21.

In contrast, the claimed invention is dealing with the problems associated with increasing execution of application code. Accordingly, because Chaddha is nonanalogous art, the Office Action cannot rely on Chaddha as a reference for a basis for rejection of claim 1. Therefore, the Office Action has not made out a *prima facie* case of obviousness.

Applicant, therefore, respectfully submits that the rejection of claim 1 has been overcome and that this claim is in condition for allowance. Because claims 2-5 depend from and further define claim 1, Applicant respectfully submits that the rejection of claims 2-5 have been overcome and that these claims are in condition for allowance.

Claims 6-7 and 9 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.*, Chaddha in view of Chung *et al.* (U.S. 5,481,472). In light of the remarks set forth regarding that both Chaddha and Chung are nonanalogous art (see remarks regarding claim 13 for discussion of Chung) and because claims 6-7 and 9 depend from and further define claim 1, Applicant respectfully submits that the rejection of claims 6-7 and 9 have been overcome and that these claims are in condition for allowance.

Claims 8, 10-12, 22, 28 and 30 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.*, Chung *et al.*, Chaddha in view of Ozluturk *et al.* (U.S. 6,516,022). In light of the remarks set forth regarding that both Chaddha and Chung are nonanalogous art and because claims 8, 10-12, 22, 28 and 30 depend from and further define claims 1, 13 and 23, respectively, Applicant respectfully submits that the rejection of claims 8, 10-12, 22, 28 and 30 have been overcome and that these claims are in condition for allowance.

Claims 13-14 and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.* in view of Chung *et al.* Applicant respectfully traverses this rejection. Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness because one of the cited references (Chung) is nonanalogous art. Chung relates to "data

compaction" for "the development of integrated circuits". See, for example, Chung at column 5, lines 49-55. As noted in "Summary of the Invention" section of Chung:

> It is a further object of the invention to provide an enhancement of control of an automated tool, particularly for control of a pattern by exposure to an electron beam, by compression of data having recurrent patterns therein. Chung at column 3, lines 20-23.

Chung (in relation to the claimed invention) is not analogous by either definition of "nonanalogous art", as set forth above. Control of an automated tool (Chung) is not the same field of technology as code reuse (the claimed invention). Moreover, Chung does not deal with the same problem as the claimed invention. Chung is dealing with the problem of controlling an exposure tool for development of integrated circuits. See Chung at column 2, line 61 - column 3, line 9. In contrast, the claimed invention is dealing with the problems associated with increasing execution of application code. Accordingly, because Chung is nonanalogous art, the Office Action cannot rely on Chung as a reference for a basis for rejection of claim 13. Therefore, the Office Action has not made out a *prima facie* case of obviousness.

Applicant, therefore, respectfully submits that the rejection of claim 13 has been overcome and that this claim is in condition for allowance. Because claims 14 and 19-21 depend from and further define claim 13, Applicant respectfully submits that the rejection of claims 14 and 19-21 have been overcome and that these claims are in condition for allowance.

Claims 15-16 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.* in view of Chung *et al.* and Chaddha. In light of the remarks set forth regarding Chaddha and Chung being nonanalogous art and because claims 15-16 depend from and further define claim 13, Applicant respectfully submits that the rejection of claims 15-16 have been overcome and that these claims are in condition for allowance.

Claims 17-18 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.* in view of Chung *et al.* and Lopresti *et al.* (U.S. 5,832,474). In light of the remarks set forth regarding Chung being nonanalogous art and because claims 17-18 and 29 depend from and further define claims 13 and 23, respectively, Applicant respectfully submits

that the rejection of claims 17-18 and 29 have been overcome and that these claims are in condition for allowance.

Claims 23-27 were rejected under 35 USC § 103(a) as being unpatentable over Connors *et al.* in view of Chung *et al.* and Chaddha. In light of the remarks set forth regarding that both Chaddha and Chung are nonanalogous art, Applicant respectfully submits that the rejection of claims 23-27 have been overcome and that these claims are in condition for allowance.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2103) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 10-22-03

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22 day of October, 2003.

KACIA LEE
Name

Kacia Lee
Signature